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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,185

Applicant(s)

PROPST JR, CHARLES W.

Examiner

Christopher P. Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,7,10-13,15-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,7,10-13,15-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

WITHDRAWN REJECTIONS

1. The 35 U.S.C. 112 rejections of claims 5, 7, 10-13, 15-18, and 20 of record in the Office Action mailed April 13, 2005, Pages 2-5 Paragraph 2, have been withdrawn due to Applicant's amendments in the Paper filed July 13, 2005.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The 35 U.S.C. 103 rejections of claims 5 and 7 over Shaw in view of Sugimoto are repeated for the reasons set forth in the previous Office Action mailed April 13, 2005, Pages 5-6 Paragraph 3.

Regarding the newly added limitations to claim 5, Shaw teaches a film-forming composition in direct contact with a paper layer. The limitation "said polymeric composition being a dried layer formed from an intermediate composition" is the interpretation the claim was given previously, so that limitation has already been addressed. The limitation that the intermediate composition comprises "an aqueous methyl

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methacrylate polymer base solution" rather than aqueous resin differentiates the intermediate composition of the claims from the intermediate composition of the Shaw reference, but does not overcome the fact that the claimed invention is a paper layer coated with a dried film. Shaw teaches that the colloidal dispersion is dried and is a film forming dispersion.

Therefore, the final product of Shaw is a paper layer coated with a dried film in which the coating has the same composition as the claimed invention. Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. See MPEP 2113. The limitation "said polymeric composition being deposited on said paper in an aqueous form and dried to form said film of polymeric composition" is taught by Shaw because the colloiddally dispersed in water film forming material is deposited on said paper and dried to form a film.

3. The 35 U.S.C. 103 rejections of claims 10-12, 15-17, and 20 over Keough in view of Sugimoto are repeated for the reasons set

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forth in the previous Office Action mailed April 13, 2005, Pages 6-7 Paragraph 4.

All of the newly added limitations are process and/or intermediate step limitations that receive little patentable weight in an article claim. The product being claimed is a package comprising at least two layers in which one layer is paper, fabric, or non-woven material and the other layer is a coating applied directly to the first layer. The coating is a dry film having a certain composition as claimed. Keough teaches the first layer and a second coated film applied directly to the first layer having the same composition as claimed. Keough does not teach applying that film by the same process as claimed, including applying the film as a solution that must be dried after being applied. However, it has been established that a different process can make the same product. In this case, the claimed invention and the invention taught by Keough and Sugimoto are either the same or similar in that both products are packages having a substrate layer and a film of the same polymeric composition. Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process including different intermediate steps, the burden shifts to applicant to come forward with evidence

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establishing an unobvious difference between the claimed product and the prior art product.

4. The 35 U.S.C. 103 rejections of claims 13 and 18 over Keough in view of Sugimoto and Felter are repeated for the reasons set forth in the previous Office Action mailed April 13, 2005, Pages 7-8 Paragraph 5.

Regarding the newly added limitation to claims 10 and 15, see rejection of claims 10 and 15 above.

5. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keough in view of Sugimoto as applied to claims 10 and 15 above, and further in view of Shaw (USPN 4,379,822).

Keough and Sugimoto teach all that is claimed in claims 10 and 15 as shown above, but fail to explicitly teach that the acrylic polymer is methyl methacrylate. Keough does teach that the polymer is acrylic and provides some examples such as n-isobutoxymethylacrylamide and ethoxyethoxyethylacrylate (col.3, 1.17-19), which are similar to methyl methacrylate. Keough also teaches that the particular acrylic selected depends on the final coating properties desired (col.3, 1.10-16). Shaw teaches that in the art of forming anti-static conductive coatings on

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substrates such as paper methyl methacrylate is a well known acrylic used in forming the coating (col.5, 1.34). One of ordinary skill in the art would have recognized that Keough, Sugimoto and Shaw are analogous insofar as all of the references are concerned with antistatic coatings or films applied to substrates to render the substrate antistatic.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to select methyl methacrylate as the acrylic used in Keough since methyl methacrylate is a well known acrylic for that use as taught by Shaw, and Keough teaches that the acrylic chosen is selected from well known acrylics depending on the intended end properties and results of the final coating.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments regarding the 35 U.S.C. 112 rejections of record have been considered but are moot since the rejections have been withdrawn.

7. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 5 and 7 over Shaw in view of Sugimoto have been fully considered but they are not persuasive.

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In response to Applicant's argument that Shaw fails to teach a solution and instead teaches a film forming colloidal dispersion, although Shaw does teach a dispersion rather than a solution it is not clear that the two resulting products are distinctly different. Shaw specifically teaches that the dispersion in water is a film-forming resinous material (col.4, 1.3-11). Therefore, when the dispersion is dried it is a film directly in contact with the paper substrate. The film of Shaw is not a mere agglomeration of solid particles in the final product it is a film as specifically stated in col.4, 1.3-11. Thus, the product of Shaw is a paper layer in direct contact with a film having the same composition as claimed. Claim 5 is drawn to a paper layer coated with a film not to a paper layer coated with aqueous solution. The limitation regarding the form of the film prior to drying is an intermediate step in the formation of the product claimed and therefore is the equivalent to a process step. The final product of both the claimed invention and Shaw are the same or at least similar and the final product is what is being claimed. Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process including different intermediate steps, the burden shifts to applicant to come

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forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

8. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 10-13, 15-18, and 20 over Keough in view of Sugimoto and (also in view of Felter as applied to claims 13 and 18) have been fully considered but they are not persuasive.

In response to Applicant's argument that the intermediate product being an aqueous solution produces a different structure than the structure produced by the combination of Keough and Sugimoto, although there may be slight differences there is no proof that the two products are distinctly different or that the claimed invention is unobvious over the structure produced by the combination of Keough and Sugimoto. Claims 10 and 15 are drawn to a film in direct contact with a substrate not to a substrate in direct contact with an aqueous solution. The limitation regarding the form of the film prior to drying is an intermediate step in the formation of the product claimed and therefore is the equivalent to a process step. The product being claimed is a package comprising at least two layers in which one layer is paper, fabric, or non-woven material and the other layer is a coating applied directly to the first layer. The coating is a dry film having a certain composition as

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claimed. Keough teaches the first layer and a second coated film applied directly to the first layer having the same composition as claimed. Keough does not teach applying that film by the same process as claimed, including applying the film as a solution that must be dried after being applied. However, it has been established that a different process can make the same product. In this case, the claimed invention and the invention taught by Keough and Sugimoto are either the same or similar in that both products are packages having a substrate layer and a film of the same polymeric composition. Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process including different intermediate steps, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB

September 7, 2005


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

9/7/05